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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/033,401
Filing Date: December 26, 2001
Appellant(s): ROSENBERG, SCOTT A.

David L. Ciesielski
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 4/21/2010 appealing from the Office action mailed 1/15/2010.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

1, 7-10, 12-13, 20-21, 23, 27-33, 35-38

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

US 2001/0049820	BARTON	12-2001
5,272,525	BORCHARDT et al	12-1993
US 2003/0195797	KLUG	10-2003
7,337,456	NIHEI	2-2008

Official Notice (that: "A long time ago George Lucas used a "wipe" technique heavily in the Star Wars original trilogy (1977+) whereby a first scene (first video mode) was wiped over by a second scene (second video mode). In the middle stages of this wipe, both scenes were simultaneously on the screen but without overlap.").

Because applicant has not challenged the fact-finding of this Officially Noticed evidence, no citation to a publication has been provided.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 7-10, 12, 13, 20, 21, 23, 27-28, 31, 33, 35-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barton (US2001/049820) in view of Official Notice.

Regarding claims 1, 20, 21, 27-28, 33, 35-36, Barton teaches a DVR (connected to a display device of a TV) with software that enables a user to select (during a first mode where figure 2's menu/index/list of pre-recorded programs is offered on the screen) a program for requested playback. Barton teaches a bookending function which can insert and play advertising before the user-selected, pre-recorded program is played. The bookending function also may play advertising after the program playback [abstract, 0014]. Both the beginning and end of the requested program content are taken to represent detections of a mode change and trigger obtaining/determination of an appropriate advertisement. Regarding the claimed feature that the advertising is displayed simultaneously with the video of the modes, it is unstated in Barton whether or not there is any simultaneous display of 1st mode (the index/menu) with the ad or whether or not there is any simultaneous display of the ad with the 2nd mode (the requested program). However it is clear that Barton teaches a sequence of 1st mode (index/menu),...advertising...2nd mode (the requested program). Official Notice is taken that it was well known to enhance video content by including visual transitions between portions of video content. One typical video transition has been traditionally referred to as a "wipe" – much as applicant describes in his figure 3(d) and referred to as a "wipe"

in the instant specification and current claims. A long time ago George Lucas used this technique heavily in the Star Wars original trilogy (1977+) whereby a first scene (first video mode) was wiped over by a second scene (second video mode). In the middle stages of this wipe, both scenes were simultaneously on the screen but without overlap. One of ordinary skill has understood that video transitions such as a "wipe" (and others such as "dissolve", "fade", "blinds", etc.,) help smooth or create fanciful transitions between different video portions. It would have been obvious to one of ordinary skill at the time of the invention to have provided any of such well known transitions including vertical or horizontal wipes between the "modes" of Barton (menu transitions into the ad; the ad transitions into the selected program). By doing such a wipe, Barton's index would be displayed simultaneously on the screen as the ad, but would eventually be wiped off the screen by the ad. Likewise, the end of the advertising content would be wiped off the screen with the start of the selected program.

Regarding claims 7-10, 13, Barton teaches that the ads are pre-stored on the device and that they can be selected on the basis of the viewer's preferences and personal information [0015]. This is taken to provide a real-time and dynamic selection of ads based upon previously collected user information. Claim 10's "context information" is quite broad and could be met by virtually any information used for the bookend feature: the context that there is a transition to the start of a requested program, the context that there is a transition from the end a requested program, the context that the ads are targeted to the audience that the viewer is a part of [0015], the

context of the genre, etc. The bookend programming/functionality [fig 9: 904] is taken to provide an ad placement engine.

Regarding claim 12, while any moving video content can be taken to be animation (i.e. simple motion), Official Notice is taken that TV commercials have for decades included cartoon animation, such as the Snap, Crackle and Pop characters for Kellogg's Rice Krispies™. It would have been obvious to one of ordinary skill at the time of the invention to have provided at least some of the advertisements of Barton as animations in a manner as well known.

Regarding claim 23, Official Notice is taken that some TV advertising has for years included a still image (for example a textual ad for a business which textually lists the name, address and phone number of the business) which is rendered as video frames for a period of time long enough for a viewer to read the pertinent information. Another example is the ubiquitous FBI warning message text screen that has accompanied purchased/rented movies for many years before applicant's filing date. It would have been obvious to one of ordinary skill at the time of the invention to have inserted any such type of advertising, including a replicated still frame.

Regarding claim 31, Barton teaches downloading of the ads from a server [0049]. They are then stored obtained from memory when needed for display.

Claims 29, 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barton (US2001/049820) in view of Official Notice as above, and further in view of Borchardt et al (US5272525).

Regarding claims 29, 30, Barton does not specify how the display device is connected to the DVR, however Borchardt et al describes typical connections between video sources hardware and TV displays as being wired [1:20-27] or as wireless transmissions [abstract]. It would have been obvious to one of ordinary skill at the time of the invention to have connected the DVR hardware of Barton in any such known manner.

Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barton (US2001/049820) in view of Official Notice as above, and further in view of Klug (US2003/0195797).

Regarding claim 32, Barton teaches targeting advertising to a user's preferences such as types of programming (e.g. sci-fi), but does not explicitly teach the use of a program title. Klug teaches targeted advertising to television programming and teaches that the programs title can be used as a basis to determine appropriate advertising [0032]. It would have been obvious to one of ordinary skill at the time of the invention to have used such title-based targeting with the invention of Barton in order to provide relevant advertising to the viewer.

Claims 37-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barton (US2001/049820) in view of Official Notice as above, and further in view of Nihei (US7337456).

Regarding claims 37, 38, Barton does not appear to teach advertising based on time or location. However Barton does teach that the DVR can insert advertising that is targeted to that particular user (preferences, gender, age, hobbies, for examples) and that this targeted nature of the advertising enables the DVR provider to charge higher prices to advertisers [0048]. Nihei teaches a system which dynamically selects and presents advertising to a user, the advertising being chosen according to time and location. The advertising metadata which includes parameters of location and time (such as sales events and business hours) is compared to the user's context (time, location) and appropriately targeted advertising is chosen to show to that specific user [8/38-56; 13/25-30; 14/4-9, 39-47]. Nihei teaches that this leads to ads of interest to the user, provides effective ads that suit the circumstances of the individual user, increases probability of purchases and provides greater sales opportunities [16/41-63]. Therefore these benefits achieved by targeting advertising to time and location (i.e. advertising a burger restaurant's sales during business hours of that particular local restaurant location) would have been obvious to have provided with that of Barton, thereby offering increasing the effectiveness of (and ability to charge higher rates for) the single-user targeting sought by Barton. It would have been obvious to one of ordinary skill at the time of the invention to have determined the location of Barton using any well accepted techniques including a simple questionnaire to develop a profile that includes location, hobbies, gender, age, etc.

(10) Response to Argument

Applicant questions the examiner's explanation "regarding the claimed feature that the advertising is displayed simultaneously with the video mode" and applicant argues that this does not appear in the claims as such. Examiner is aware of the claim language, but merely was summarizing that Barton fails to teach displaying the advertising simultaneously with either the index of programs or with the recorded program. The action should however make it clear that Barton indeed teaches transitioning from an Index of programs TO an advertisement AND THEN from the advertisement TO the recorded program. Barton fails to describe the *nature* of the transitions – are they clean cuts between the index and the ad and between the ad and the recorded program? Or are they non-clean cuts between the visual segments? Barton does not appear to specify. So one having ordinary skill would find it obvious to consider any well known video transition technique in order to change from the index to the advertisement and from the advertisement to the recorded program. Given that the wipe technique is a well known and previously-known technique (applicant's specification properly refers to it as a wipe; George Lucas used such a wipe between scenes), it would have been obvious to one of ordinary skill at the time of the invention to have used a wipe technique to transition from the index of programs to the advertising and from the advertising to the user-requested recorded program. Doing so provides for a particular pleasing look that is not achieved with an abrupt, and clean cut between video segments.

Applicant argues (with respect to Barton's FIG 1 arrows from each of 104 and 106) that:

"Viewer Interface 104 and Output module 106 provide separate outputs. Appellant submits that Barton does not disclose or suggest that the digital video recording system places an ad into either of those separate outputs so that either of those outputs simultaneously includes the index of programs recorded at the DVR (e.g., the list 201) and the ad but does not include the video of the program recorded at the DVR.

Examiner agrees that Barton fails to teach "outputs simultaneously includes the index of programs recorded at the DVR (e.g., the list 201) and the ad but does not include the video of the program recorded at the DVR". The silence on the simultaneous display of two adjacent video segments was reason to bring in the Official Notice (wipe transition) in an obvious rejection. Barton is assumed by the examiner to provide a DVR which places a stream displayed on the viewers TV screen which includes the index_of_programs --> advertising --> recorded_program. Therefore the claim language is met, save for the nature of the transitions (the arrows: -->).

Moving to the Official Notice and "wipe" transitions, applicant's assumption (ii) (Brief, pg 11, line 3) is exactly the nature of the Official Notice – that George Lucas's Star Wars original trilogy used wipe transitions between scenes. Applicant has introduced a bit of confusion with assumption (i) that Star Wars amounts to the 'program material' in the claim and assumption (iii) that the "list (index) of programs" include Star Wars. Examiner is noting the prior knowledge of wipe transitions and has reasoned it to have been obvious to have used wipes with the transitions required by Barton (namely, the transition from index to ad AND the transition from ad to program). Use of a wipe transition between two adjacent video segments (whether they are scenes, indexes,

ads, or programs) inherently provides for simultaneous display of the two segments during the wipe - much as shown at the very bottom of applicants figure 3(d). Using wipes between the visual segments of Barton (index to ad, ad to program) would therefore provide for a predictably pleasing effect to the viewer. This is true regardless of the fact that Lucas's Star Wars may have only used wipes between different scenes within the Star Wars program. In essence, it would have been obvious to one of ordinary skill at the time of the invention to have used any type of known transition (horizontal wipe, vertical wipe, fade, dissolve, 'blinds', etc.,) between the video modes of Barton, even when Star Wars was limited to transition between scenes of the same program/movie content.

Examiner is *not* arguing that if Barton's DVR is used simply to record and request playback of Star Wars, then the claim would be met. The obviousness-based rejection set forth above meets the claim, regardless of what program content is recorded and played back by Barton – although recording and then viewing Star Wars on the DVR of the *modified* Barton DVR would meet the claim.

Applicant has taken the approach to make statements/arguments why he would not have determined that Barton and prior-art wipe transitions together would lead to the claimed invention. However applicant has not shown arguments why the prima facie case presented by the examiner is flawed.

Lastly, while applicant provides additional sections of arguments to address the other claims and applied art, there are no further arguments of merit. Therefore

examiner has not provided any additional argument in support of his additional rejections which are believed to have been proper in what they address.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Jeffrey D. Carlson/
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